

Benjamin J. Hofileña (State Bar No. 227117)  
bhofileña@orrick.com  
ORRICK, HERRINGTON & SUTCLIFFE LLP  
777 South Figueroa Street  
Suite 3200  
Los Angeles, CA 90017  
Telephone: +1-213-629-2020  
Facsimile: +1-213-612-249

Mark D. Litvack (State Bar No. No. 183652)  
mlitvack@reedsmith.com  
Michael A. Garabed (State Bar No. 223511)  
mgarabed@reedsmith.com REED SMITH LLP  
1901 Avenue of the Stars, Suite 700  
Los Angeles, CA 90067  
Telephone: +1-310-734-5217  
Facsimile: +1-310-734-5299

Attorneys for Defendants and Counterclaimants  
AOL LLC, TIME WARNER INC., and PLATFORM-A  
INC.

**UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA  
WESTERN DIVISION**

MODAVOX, INC., a Delaware  
corporation,

Plaintiff,

v.

AOL LLC, a Delaware limited liability  
company, Time Warner Inc., a Delaware  
corporation, and Platform-A Inc., a  
Maryland corporation,

Defendants

AND RELATED COUNTERCLAIMS

Case No. CV08-05914 SJO (PJWx)

**DEFENDANTS' NOTICE OF  
MOTION AND MOTION TO  
TRANSFER ACTION TO U.S.  
DISTRICT COURT FOR  
SOUTHERN DISTRICT OF NEW  
YORK**

The Honorable S. James Otero

Hearing Date: March 23, 2009  
Time: 10:00 AM  
Courtroom: 880

**TO ALL PARTIES AND THEIR ATTORNEYS OF RECORD:**

**PLEASE TAKE NOTICE** that on March 23, 2009 at 10:00 a.m., or as soon thereafter as the matter may be heard, in the courtroom of the Honorable S. James Otero, United States District Court, in Courtroom No. 880 of the above-entitled Court, located at 225 East Temple Street, Los Angeles, California, Defendants AOL LLC, Time Warner Inc., and Platform-A, Inc. will and hereby do move the Court for an order transferring this action to the United States District Court for the Southern District of New York pursuant to 28 U.S.C. § 1404(a).

Pursuant to 28 U.S.C. § 1404(a), Defendants AOL LLC, Time Warner Inc., and Platform-A Inc. seek an order transferring this action to the United States District Court for the Southern District of New York where a pending action between the same plaintiff and a subsidiary of the named defendants based on the same patent claims and the same technology at issue in the instant case has been intensely litigated for *a year and a half*, including a lengthy *Markman* hearing.

This Motion is based on this Notice of Motion and Motion, the Memorandum of Points and Authorities below; the accompanying Declaration of Paul R. Gupta, and [Proposed] Order filed simultaneously herewith; all pleadings on file in this action; oral argument of counsel; and any other matter that may be submitted at the hearing or thereafter in connection with this motion.

This motion is made following the conference of counsel pursuant to L.R. 7-3 which took place on February 10, 2009.

1 Dated: March 2, 2009

Respectfully submitted,

2 ORRICK, HERRINGTON & SUTCLIFFE LLP

3 By: /s/Benjamin Hofileña

4 Benjamin J. Hofileña (SBN 227117)  
5 ORRICK, HERRINGTON & SUTCLIFFE LLP  
6 777 South Figueroa Street, Suite 3200  
7 Los Angeles, CA 90017  
Telephone: +1-213-629-2020  
Facsimile: +1-213-612-2499

8 Mark D. Litvack (State Bar No. 183652)  
9 Michael A. Garabed (State Bar No. 223511)  
10 REED SMITH LLP  
11 1901 Avenue of the Stars, Suite 700  
Los Angeles, CA 90067  
Telephone: +1-310-734-5217  
Facsimile: +1-310-734-5299

12 Attorneys for Defendants and Counterclaimants  
13 AOL LLC, TIME WARNER INC., and  
14 PLATFORM-A INC.

## TABLE OF CONTENTS

		Page
1		
2		
3	I. INTRODUCTION .....	1
4	II. STATEMENT OF FACTS .....	3
5	A. The Parties .....	3
6	1. Plaintiff .....	3
7	2. Defendants .....	3
8	B. The Present Action Is Duplicative of the Litigation Pending in	
9	the New York Court .....	4
10	C. The New York Litigation Has Been Very Active, Making the	
11	New York Court Very Familiar With the Parties, the	
12	Patents-in-Suit, and the Accused Technology .....	5
13	III. ARGUMENT .....	6
14	A. Transferring This Case is Proper Pursuant to 28 U.S.C. §	
15	1404(a) .....	6
16	B. This Action Could Have Been Brought in the Southern District	
17	of New York .....	8
18	C. The “Interests of Justice” Warrant Transfer to Avoid the Waste	
19	of Judicial Resources and the Risk of Inconsistent Results .....	8
20	D. Modavox’s Choice of Forum Is Entitled to Little Weight Here	
21	and Modavox Cannot Argue that the Southern District of New	
22	York is Inconvenient, Because Modavox Itself Chose to Litigate	
23	the Same Patents Against a Related Defendant Regarding the	
24	Same Technology in the Southern District of New York .....	11
25	IV. CONCLUSION .....	12
26		
27		
28		

## TABLE OF AUTHORITIES

	Page
<b>CASES</b>	
<i>Broadcast Data Retrieval Corp. v. Sirius Satellite Radio, Inc.</i> , No. CV 06-1190(JFW)(SSX), 2006 WL 1582091 (C.D. Cal. June 6, 2006) .....	6
<i>Continental Grain Co. v. Barge FBL-585</i> , 364 U.S. 19 (1960).....	6, 8
<i>CoxCom, Inc. v. Hybrid Patents Inc.</i> , No. C-06-7918 MMC, 2007 WL 2500982 (N.D. Cal. Aug. 30, 2007).....	12
<i>Electronics for Imaging, Inc. v. Tesseract, Ltd.</i> , No. C 07-05534 CRB, 2008 WL 276567 (N.D. Cal. Jan. 29, 2008) .....	9
<i>George v. Nat'l Collegiate Athletic Ass'n</i> , No. CV 08-03401(GAF)(AGRx), 2008 WL 5422882 (C.D. Cal. 2008) .....	7
<i>Inline Connection Corp. v. Verizon Internet Services, Inc.</i> , 402 F. Supp. 2d 695 (E.D. Va. 2005).....	9, 10, 11
<i>In re TS Tech USA Corp.</i> , 551 F.3d 1315 (Fed. Cir. 2008) .....	11
<i>In re Volkswagen of Am., Inc.</i> , 545 F.3d 304 (5th Cir. 2008), <i>cert. denied</i> , 77 U.S.L.W. 3366 (U.S. Feb. 23, 2009) (No. 08-754) .....	7
<i>Jaco Environmental, Inc. v. Appliance Recycling Centers of America, Inc.</i> , No. C 06-06601 JSW, 2007 WL 951274 (N.D. Cal. Mar. 27, 2007).....	9
<i>Pacific Car &amp; Foundry Co. v. Pence</i> , 403 F.2d 949 (9th Cir. 1968) .....	11
<i>Regents of Univ. of Cal. v. Eli Lilly &amp; Co.</i> , 119 F.3d 1559 (Fed. Cir. 1997) .....	8
<i>Reiffin v. Microsoft Corp.</i> , 104 F. Supp. 2d 48 (D.D.C. 2000).....	10
<i>SAES Getters v. Aeronex, Inc.</i> ,	

**TABLE OF AUTHORITIES**  
(continued)

	<b>Page</b>
219 F. Supp. 2d 1081 (S.D. Cal. 2002) .....	9
<i>Sorensen v. Phillips Plastics Corp.</i> , No. C-08-03094 MHP, 2008 WL 4532556 (N.D. Cal. Oct. 9, 2008) .....	9
<i>Univ. of Pittsburgh v. Varian Medical Sys., Inc.</i> , No. C-08-2973, 2008 WL 4279704 (N.D. Cal. Sep. 16, 2008) .....	9, 11, 12
<i>Van Dusen v. Barrack</i> , 376 U.S. 612 (1964) .....	6, 8
<i>Williams v. Bowman</i> , 157 F. Supp. 2d 1103 (N.D. Cal. 2001) .....	7

**FEDERAL STATUTES**

28 U.S.C. § 1404(a) .....	1, 3, 6, 7, 13
---------------------------	----------------



## MEMORANDUM OF POINTS AND AUTHORITIES

### I. INTRODUCTION

The Court should transfer this case to the Southern District of New York because the parties are engaged in ongoing litigation in that judicial district involving the same patents-in-suit and the same technology that is at issue here.<sup>1</sup> Plaintiff Modavox, Inc. (“Modavox”) previously filed a patent infringement lawsuit in the Southern District of New York (the “New York Court”) accusing TACODA, Inc. (“Tacoda”) a subsidiary of one of the named defendants in the present action before this Court. Modavox has now sued AOL LLC (“AOL”), Time Warner Inc. (“Time Warner”), and Platform-A Inc. (“Platform-A”) (collectively, “Defendants”) for infringement of the same patents by virtue of the Tacoda technology.<sup>2</sup> In fact, in a recent press release, Modavox acknowledged that it has accused the same technology in both cases: “AOL’s expansion of its subsidiary, Tacoda, Inc.’s Behavioral [sic] Targeting across Platform A has clearly appeared to embody the same underlying method to achieve targeted delivery advertising to consumers.” *See Gupta Dec. at Ex. D.*

Principles of judicial economy, basic fairness, and convenience dictate that the present action should be transferred to the New York Court pursuant to 28 U.S.C. § 1404(a). The New York Court has spent the past *year and a half* studying the patents-in-suit and the technology at issue. It has presided over case management conferences, discovery, and claim construction, including a *Markman* hearing. Further, the New York Court continues to consider claim construction questions, most recently on February 20, 2009, requesting additional briefing from the parties to construe an ambiguous claim term. *See Gupta Dec. at ¶ 18.* Given its

<sup>1</sup> A conference of counsel pursuant to L.R. 7-3 took place on February 10, 2009. *See Declaration of Paul R. Gupta (“Gupta Dec.”) at ¶ 19.*

<sup>2</sup> Modavox itself acknowledged the overlap of these two litigations in its Notice of Pendency of Other Actions, stating: “The New York Action sets forth infringement claims against Tacoda, Inc., a subsidiary of AOL LLC for infringement of the same patents [at issue in the present action].” *See Notice of Pendency of Other Actions, dated February 10, 2009.*

1 substantial knowledge of the patents, technology, and parties, the New York Court  
2 is well-suited to preside over the present action.

3 Moreover, allowing the present action to proceed in the Central District of  
4 California would run the risk of inconsistent judgments on identical issues between  
5 like parties. Indeed, the Honorable Colleen McMahon, who is presiding over the  
6 New York Litigation, commented on this possibility when she learned of Modavox  
7 having filed the present action:

8 THE COURT [Judge McMahon]: Who else are you suing?

9 MR. [DAVID] SHAUB [Counsel for Modavox in the present action  
10 and the New York Litigation]: AOL, Time Warner and Tacoda and  
Platform A.

11 THE COURT: And you are suing these people in a whole bunch of  
12 different places in the hope that you are going to get different  
interpretations of the same patent by different judges?

13 MR. SHAUB: No.

14 THE COURT: Oh baloney.

15 *See Gupta Dec. at Ex L.*

16 Other factors of convenience also support a transfer to the New York Court.  
17 The present action has no particular connection to this judicial district – neither  
18 Modavox nor any Defendant is located in the Central District of California.  
19 Outside of routine business activities, Defendants' presence in this District is  
20 virtually indistinguishable from any other judicial district in this country, except for  
21 the Southern District of New York where Modavox has chosen to file suit and  
22 where Defendants are all headquartered.

23 In addition, litigation in this District will not improve the access to witnesses  
24 or evidence. Third party witnesses, most importantly, the named inventors, are also  
25 not located in this District. On the other hand, because Defendants maintain offices  
26 in New York, other witnesses, such as employees of Defendants, as well as relevant  
27 documentary evidence, are located in that judicial district. Finally, Modavox  
28 clearly cannot claim that the Southern District of New York is inconvenient, given



1 that it chose to initiate litigation of the patents-in-suit in that district and has been  
2 engaged in litigation there for a year and a half.

3 For these reasons, and as explained in greater detail below, Defendants  
4 respectfully request that this Court issue an order transferring the present action to  
5 the United States District Court for the Southern District of New York for all  
6 further proceedings, pursuant to 28 U.S.C. § 1404(a).

## 7 **II. STATEMENT OF FACTS**

### 8 **A. The Parties**

#### 9 **1. Plaintiff**

10 Plaintiff Modavox is a Delaware corporation with its principal place of  
11 business in Arizona. *See* First Amended Complaint at ¶ 2. Modavox is the  
12 purported owner of the patents-in-suit, U.S. Patent No. 6,594,691 (the “691  
13 Patent”) and No. 7,269,636 (the “636 Patent”). *See id.* at ¶¶ 33, 44. The patents-  
14 in-suit identify named inventors Charles P. McCollum and Andrew L. Burgess, Jr.,  
15 both residents of Arizona. *See* Exhibits A and B to First Amended Complaint.  
16 Modavox further alleges to be the owner of the federally-registered trademark  
17 “Boombox Radio.” *See* First Amended Complaint at ¶¶ 11-14.

#### 18 **2. Defendants**

19 Defendant AOL is a Delaware limited liability company with its headquarters  
20 in New York, New York. *See* Declaration of Paul Gupta (“Gupta Dec.”) at ¶ at 4.  
21 Defendant Time Warner is a Delaware corporation with its headquarters in New  
22 York, New York. *Id.* Defendant Platform-A is Delaware corporation with its  
23 headquarters in New York, New York. *Id.* Tacoda, the defendant in the ongoing  
24 litigation in the New York Court, is a subsidiary of Platform-A. *Id.* at ¶ 5. In turn,  
25 Platform-A is a subsidiary of AOL, which is a wholly-owned subsidiary of AOL  
26 Holdings LLC, which is a majority-owned subsidiary of TW AOL Holdings Inc.,  
27 which is a wholly-owned subsidiary of Time Warner. *Id.* at ¶ 4. Defendants AOL  
28 and Time Warner maintain offices in the Central District of California; defendant

Platform-A does not. *Id.*

**B. The Present Action Is Duplicative of the Litigation Pending in the New York Court**

In the present action, Modavox accuses the identical technology of infringing the same patents-in-dispute that Modavox previously accused in the ongoing patent infringement litigation in the New York Court (the “New York Litigation”).

Specifically, Modavox filed suit against Tacoda in the Southern District of New York in August, 2007, accusing Tacoda of infringing the ‘691 and ‘636 Patents.

*See Gupta Dec.*, Exs. A and B. The alleged infringement in the New York Litigation is based on Tacoda’s behavioral targeting technology according to Modavox’s own statements. *See Gupta Dec.* at ¶ 7.

Similarly, in the present action, Modavox accuses Defendants of infringing the ‘691 and ‘636 Patents. *See First Amended Complaint.* Likewise, the alleged infringement is also based on the same Tacoda technology accused in the New York Litigation. In particular, Modavox has described in a press release the basis for its allegations of infringement as AOL’s expansion of Tacoda’s technology across Platform-A. *See Gupta Dec.* at Ex. D. Modavox provided further confirmation of the basis for its new suit during a meet and confer on February 10, 2009 between counsel for the parties to discuss the instant motion. During that conference, Modavox’s counsel indicated that the Tacoda technology is the primary basis for the patent infringement allegations of the present action. *See id.* at ¶ 8.

Here, Modavox also accuses AOL of infringing Modavox’s “Boombox” trademark. *See First Amended Complaint* at ¶¶ 16-18, 28-30. Aside from this trademark infringement claim instituted solely against AOL, the present action is entirely duplicative of the New York Litigation. Modavox has not pled any connection between the trademark claims and this District.

1 The New York Litigation Has Been Very Active, Making the New York  
2 Court Very Familiar With the Parties, the Patents-in-Suit, and the Accused  
3 Technology

4 The New York Litigation has been ongoing in the New York Court for  
5 eighteen months. During this time, the New York Court has interacted on  
6 numerous occasions with the parties, overseen the discovery process, and become  
7 versed in the technology and the patents-in-suit, most recently in a *Markman*  
8 hearing before Judge McMahon. *See Gupta Dec.* at ¶ 9.

9 The New York Litigation has been actively litigated since Modavox filed its  
10 initial complaint on August 9, 2007, which it later amended on September 12, 2007.  
11 *See Gupta Dec.*, Exs. A and B, respectively. Tacoda filed its Answer on October  
12 19, 2007, denying the infringement allegations and asserting counterclaims for a  
13 declaratory judgment of non-infringement and invalidity. *See Id.*, Ex. C. On  
14 November 30, 2007, a Scheduling Conference was held before Judge McMahon.  
15 *See Id.*, Ex. E.

16 Subsequently, the parties engaged in extensive fact discovery, such as  
17 interrogatories and document productions directed to the patents-in-suit and the  
18 accused technology. *See Gupta Dec.* at ¶ 10. Tacoda has also produced source  
19 code relating to the accused technology, including both historical data, as well as  
20 data relating to the Tacoda technology as now incorporated into Platform-A. *Id.* In  
21 addition, Tacoda has provided Modavox with its invalidity analysis of the patents-  
22 in-suit in support of Tacoda's invalidity counterclaim. *Id.*

23 Further, the parties continue to engage in an intensive claim construction  
24 process in the New York Litigation regarding the same patents-in-suit in the present  
25 action before this Court. *See Gupta Dec.* at ¶ 11. The parties began to meet and  
26 confer in November, 2008 to discuss claim construction terms. *Id.* Modavox and  
27 Tacoda then filed opening briefs on December 16, 2008, opposition briefs on  
28 January 8, 2009, and briefs in response to the opposition briefs on January 15,

2009. *See* Gupta Dec., Exs. F, G, H, I, J, and K.

After briefing was completed, Judge McMahon held a claim construction hearing on February 4, 2009. *See* Gupta Dec. at ¶ 18. The parties appeared before Judge McMahon, and counsel for Modavox and Tacoda gave presentations and arguments on each term in dispute. *Id.* Judge McMahon actively participated in the lengthy hearing, thoroughly questioning the parties about the patents-in-suit and the parties' proposed claim constructions. *Id.* As recently as February 20, 2009, the parties were instructed by Judge McMahon to further meet and confer and submit additional briefing on the meaning of certain terms in the asserted claims. *Id.*

### III. ARGUMENT

#### A. Transferring This Case is Proper Pursuant to 28 U.S.C. § 1404(a)

"For the convenience of parties and witnesses, in the interests of justice, a district court may transfer any civil action to any other district or division where it might have been brought." 28 U.S.C. § 1404(a). "[T]he purpose of . . . [S]ection [1404(a)] is to prevent the waste 'of time, energy and money' and 'to protect litigants, witnesses and the public against unnecessary inconvenience and expense.'" *See Van Dusen v. Barrack*, 376 U.S. 612, 616 (1964) (citing *Continental Grain Co. v. Barge FBL-585*, 364 U.S. 19, 26, 27 (1960)). A party moving for transfer must show: (1) that venue is proper in the transferor district;<sup>3</sup> (2) that the transferee district is one where the action might have been brought; and (3) that the transfer will serve the convenience of the parties and witnesses and will promote the interest of justice. *Broadcast Data Retrieval Corp. v. Sirius Satellite Radio, Inc.*, No. CV 06-1190(JFW)(SSX), 2006 WL 1582091, at \*2 (C.D. Cal. June 6, 2006).

A district court has discretion to adjudicate motions for transfer according to

<sup>3</sup> Defendants AOL and Time Warner have appeared as defendants in other cases in this District. Defendants, however, contend that the interests of justice weigh heavily in favor of transferring this case to the Southern District of New York.



an individualized, case-by-case consideration of convenience and fairness. *George v. Nat'l Collegiate Athletic Ass'n*, No. CV 08-03401(GAF)(AGRx), 2008 WL 5422882, at \*2 (C.D. Cal. 2008). The plaintiff's choice of forum is but one factor in the analysis, and the Court may consider a variety of factors in its determination of whether transfer is appropriate in a particular case, including: (1) the convenience of the parties; (2) feasibility of consolidation of other claims; (3) the convenience of the witnesses; (4) ease of access to the evidence; (5) the interests of justice; and (6) the plaintiff's choice of forum. *See Williams v. Bowman*, 157 F. Supp. 2d 1103, 1106 (N.D. Cal. 2001) (noting that there are variations in the articulated factors and that this list is not exhaustive, but comports with Ninth Circuit precedent). Other circuits have reached the same conclusion, including a case recently reviewed by the Supreme Court. *See In re Volkswagen of Am., Inc.*, 545 F.3d 304, 315-316, 319 (5th Cir. 2008) (en banc) (issuing writ of mandamus directing district court to transfer and identifying public and private factors for transfer including "practical problems that make trial of a case easy, expeditious and inexpensive" and "the familiarity of the forum with the law that will govern the case"), *cert. denied*, 77 U.S.L.W. 3366 (U.S. Feb. 23, 2009) (No. 08-754).

The relevant factors overwhelmingly balance in favor of transferring this case to the New York Court. First, venue is proper in the transferee district. Second, and most importantly, the ongoing New York Litigation involves the same allegations of patent infringement made by the same plaintiff against identical technology and similar defendants. Third, witnesses and documents are located in the Southern District of New York and not in the Central District of California. Finally, other factors of convenience and the possibility of consolidation favor transfer.

#### **B. This Action Could Have Been Brought in the Southern District of New York**

A court may transfer any action to any other district where the "action might

1 have been brought” originally. 28 U.S.C. § 1404(a). As a threshold inquiry, this  
 2 Court must determine whether the proposed transferee district, the Southern District  
 3 of New York, is one where the case “might have been brought.” This requirement  
 4 requires that the transferee forum had personal jurisdiction over the defendants at  
 5 the time the action was filed, and is easily satisfied as evidenced by the ongoing  
 6 New York Litigation *commenced* by Modavox. *See Van Dusen*, 376 U.S. at 624.  
 7 Defendants are unquestionably subject to personal jurisdiction in the Southern  
 8 District of New York, as all Defendants maintain their headquarters in New York  
 9 City within the Southern District of New York.

10 Therefore, this action could have been brought in the Southern District of  
 11 New York.

12 **C. The “Interests of Justice” Warrant Transfer to Avoid the Waste of**  
 13 **Judicial Resources and the Risk of Inconsistent Results**

14 “To permit a situation in which two cases involving precisely the same issues  
 15 are simultaneously pending in different District Courts leads to the wastefulness of  
 16 time, energy and money that § 1404(a) was designed to prevent.” *Continental*  
 17 *Grain*, 364 U.S. at 26. As in *Continental Grain*, the interests of justice are best  
 18 served by transferring this action to the New York Court where the legal issues and  
 19 facts have been fully developed by the parties. Transfer will prevent the  
 20 duplication of efforts and the possibility of inconsistent rulings by two judicial  
 21 districts on complex patent claims. It also will achieve judicial economy since the  
 22 New York Court is intimately familiar with the patents and technology. Indeed,  
 23 this fact alone justifies transfer. *See, e.g., Regents of Univ. of Cal. v. Eli Lilly &*  
 24 *Co.*, 119 F.3d 1559, 1565 (Fed. Cir. 1997) (affirming that transfer was appropriate  
 25 “after affording *determinative weight* to the consideration of judicial economy,”  
 26 since the transferee district court had “become familiar with the issues” and stating  
 27 that “[c]onsideration of the interest of justice, which includes judicial economy,  
 28 ‘may be determinative to a particular transfer motion, even if the convenience of



the parties and witnesses might call for a different result.”) (emphasis added); *see also SAES Getters v. Aeronex, Inc.*, 219 F. Supp. 2d 1081, 1094 (S.D. Cal. 2002) (“[I]t will be important for the consistent interpretation of these two similar patents to have one court, rather than two, interpret them. . . . [B]y bringing both patent claims before one court, the possibility of inconsistent judgments should be substantially minimized, if not removed.”).

Not surprisingly, district courts regularly transfer cases to other districts where the same or related patent claims have been litigated. *See, e.g., Sorensen v. Phillips Plastics Corp.*, No. C-08-03094 MHP, 2008 WL 4532556, at \*3 (N.D. Cal. Oct. 9, 2008) (granting accused infringer’s motion to transfer action to S.D. Cal., where patentee had a suit pending against the accused infringer for infringement of the same patent but for a different accused product); *Univ. of Pittsburgh v. Varian Medical Sys., Inc.*, No. C-08-2973, 2008 WL 4279704, at \*1 (N.D. Cal. Sep. 16, 2008) (“[W]here the parties have previously litigated a nearly identical claim, the public interest in avoiding duplicative litigation weighs strongly in favor of transfer.”); *Electronics for Imaging, Inc. v. Tesseran, Ltd.*, No. C 07-05534 CRB, 2008 WL 276567, at \*1-\*2 (N.D. Cal. Jan. 29, 2008) (granting patentee’s motion to transfer declaratory judgment action concerning eight patents to a forum where the patentee had originally brought an infringement suit asserting two of the same patents at issue in the declaratory judgment action); *Jaco Environmental, Inc. v. Appliance Recycling Centers of America, Inc.*, No. C 06-06601 JSW, 2007 WL 951274, at \*2-\*3 (N.D. Cal. Mar. 27, 2007) (granting accused infringer’s motion to transfer infringement action to the Central District of California where there was an unfair competition action pending between the parties that addressed the same technology and issues of patent inventorship).

Transfer is particularly appropriate in patent cases which often involve sophisticated technology and complicated patent claims. *See Inline Connection Corp. v. Verizon Internet Services, Inc.*, 402 F. Supp. 2d 695, 702 (E.D. Va. 2005)

1 (“transfer is particularly appropriate in patent cases where a prior pending lawsuit  
2 involves the same facts, transactions, or occurrences, and is warranted even when  
3 the parties are different.” *See also Reiffin v. Microsoft Corp.*, 104 F. Supp. 2d 48,  
4 56 (D.D.C. 2000) (stating that “piecemeal litigation in the complex and technical  
5 area of patent and trademark law is especially undesirable”).

6 A case that is very similar to the present action is *Inline Connection Corp. v.*  
7 *Verizon Internet Services, Inc.*, 402 F. Supp. 2d at 702-703. There, the plaintiff  
8 first filed a patent infringement suit in the District of Delaware against several  
9 defendants, including a Verizon entity. *Id.* at 697. The case against the Verizon  
10 defendant was dismissed while the action proceeded against the remaining  
11 defendants. *Id.* Nearly three years later, the plaintiff filed a second patent  
12 infringement action, this time in the Eastern District of Virginia, against 25 other  
13 Verizon entities alleging infringement of the same patents-in-suit in the ongoing  
14 Delaware action. *Id.* at 696-697.

15 In deciding whether to transfer, the Virginia court noted that the Delaware  
16 court had invested substantial time and effort presiding over the case, including  
17 determining complex claim constructions. *Id.* at 702. The court found that  
18 retaining jurisdiction would only cause unnecessary expense and duplication of  
19 efforts. *Id.* (“In light of the prospective duplication of efforts involved with two  
20 courts litigating the same patent claims brought by the same party, the balance of  
21 hardships clearly favors transfer.”). Despite the fact that the Verizon defendant  
22 from the Delaware litigation was not a party to the Virginia suit, and despite that it  
23 had been dismissed from the Delaware action, the Eastern District of Virginia  
24 nonetheless ruled in favor of transfer. *Id.* at 703 (“[T]he judicial economy factor  
25 here is so heavily weighted that it alone supports transfer to the District of  
26 Delaware.”).

27 Like the Court in *Inline*, the Court in the ongoing New York Litigation has  
28 already invested substantial time familiarizing itself with the parties, the asserted

1 patents and the accused technology. The New York Court recently conducted a  
 2 *Markman* hearing and continues to expend effort to make complex claim  
 3 construction determinations, as shown by its recent request for additional briefing  
 4 on disputed patent claim terms. If this action is not transferred, this Court would  
 5 also then need to spend considerable time familiarizing itself with the patents and  
 6 the parties, and two courts would be required to make separate determinations about  
 7 identical patent claims.

8 Accordingly, transferring this action would serve judicial economy by  
 9 avoiding duplicative proceedings and unnecessary expense, and by reducing the  
 10 likelihood of inconsistent judgments. *See Univ. of Pittsburgh v. Varian Medical*  
 11 *Sys., Inc.*, No. C-08-2973, 2008 WL 4279704, at \*1; *Inline Connection Corp.*, 402  
 12 F. Supp. 2d at 703 (“[T]he risk of inconsistent results is especially acute where, as  
 13 here, the central issues involve claim construction.”).

14 The interests of justice weigh heavily in support of transfer to the New York  
 15 Court.

16 **D. Modavox’s Choice of Forum Is Entitled to Little Weight Here and**  
 17 **Modavox Cannot Argue that the Southern District of New York is**  
 18 **Inconvenient, Because Modavox Itself Chose to Litigate the Same**  
 19 **Patents Against a Related Defendant Regarding a Related**  
 20 **Technology in the Southern District of New York**

21 In this case, substantially less deference should be paid to Modavox’s choice  
 22 of forum for several reasons. First, Modavox’s forum choice carries little weight  
 23 here because there are minimal contacts between this judicial district and the  
 24 operative facts. *See Pacific Car & Foundry Co. v. Pence*, 403 F. 2d 949, 954 (9th  
 25 Cir. 1968) (stating that where the operative facts did not occur within the plaintiff’s  
 26 originally selected forum, the plaintiff’s choice “is entitled to only minimal  
 27 consideration”); *cf. In re TS Tech USA Corp.*, 551 F.3d 1315, 1321 (Fed. Cir. 2008)  
 28 (granting mandamus petition and reversing district court’s denial of accused  
 infringer’s motion to transfer infringement action to Ohio, the accused infringer’s  
 residence, where the forum had little connection to the operative facts of the alleged

1 infringement).

2 Second, Modavox's forum choice should be given little consideration  
3 because it originally chose to sue and continues to litigate the same patent  
4 infringement claims in a different jurisdiction, the Southern District of New York.  
5 For the same reason, Modavox cannot claim inconvenience from litigating in the  
6 New York Court.

7 Here, Modavox has deliberately filed a nearly identical action in a different  
8 jurisdiction that has minimal contacts with the operative facts of the action and that  
9 is not Modavox's home forum. It is difficult to explain Modavox's decision to file  
10 in the Central District of California as anything more than forum shopping. As  
11 Judge McMahon, who is presiding over the New York Litigation, noted when she  
12 questioned Modavox whether it is suing the Defendants "in a whole bunch of  
13 different places in the hope that [it is] going to get different interpretations of the  
14 same patents by different judges". *See supra* pp. 2-3; Gupta Dec. at Ex. L.

15 Therefore, the Court should not accord any deference to Modavox's choice of  
16 forum. *See, e.g., CoxCom, Inc. v. Hybrid Patents Inc.*, No. C-06-7918 MMC, 2007  
17 WL 2500982, at \*2 (N.D. Cal. Aug. 30, 2007) (transferring declaratory judgment  
18 action to the E.D. of Tex. where the patentee had pending another infringement  
19 action involving the same patents and related corporate entities to the plaintiff  
20 where it appeared that the plaintiff had engaged in forum shopping and judicial  
21 economy favored transfer).

#### 22 **IV. CONCLUSION**

23 For the foregoing reasons, Defendants respectfully request that this Court  
24 transfer this action to the United States District Court for the Southern District of  
25 New York pursuant to 28 U.S.C. § 1404(a) in the interests of judicial economy and  
26 the convenience of the parties and witnesses involved.

1 Dated: March 2, 2009

Respectfully submitted,

2 ORRICK, HERRINGTON & SUTCLIFFE LLP

3 By: /s/Benjamin Hofileña

4 Benjamin J. Hofileña (SBN 227117)  
5 ORRICK, HERRINGTON & SUTCLIFFE LLP  
6 777 South Figueroa Street, Suite 3200  
7 Los Angeles, CA 90017  
Telephone: +1-213-629-2020  
Facsimile: +1-213-612-2499

8 Mark D. Litvack (State Bar No. 183652)  
9 Michael A. Garabed (State Bar No. 223511)  
10 REED SMITH LLP  
11 1901 Avenue of the Stars, Suite 700  
Los Angeles, CA 90067  
Telephone: +1-310-734-5217  
Facsimile: +1-310-734-5299

12 Attorneys for Defendants and Counterclaimants  
13 AOL LLC, TIME WARNER INC., and  
14 PLATFORM-A INC.



**PROOF OF SERVICE**

I am more than eighteen years old and not a party to this action. My business address is Orrick, Herrington & Sutcliffe LLP, 777 South Figueroa Street, Suite 3200, Los Angeles, California 90017.

A true and correct copy of the following document listed below, was served by transmission through the electronic service system CM/ECF of the United States District Court, Central District of California:

**DEFENDANTS' NOTICE OF MOTION AND MOTION TO  
TRANSFER ACTION TO U.S. DISTRICT COURT FOR SOUTHERN  
DISTRICT OF NEW YORK**

The undersigned hereby certifies that all counsel of record who are deemed to have consented to electronic service are being served with a copy of this document via the Court's CM/ECF system per Local Rule CV-5(a)(3) on March 2, 2009.

The above-referenced document was also served on the following people listed below via the means indicated:

☒ **BY PERSONAL SERVICE:** I caused the above-referenced document to be delivered by hand to the office set forth below:

David R. Shaub  
Lisbeth Bosshart  
Stephen D. Morgan  
SHAUB & WILLIAMS LLP  
12121 Wilshire Boulevard, Suite 205  
Los Angeles, CA 90025-1165

☒ **BY MAIL:** I caused the above-referenced document to be served by mail by placing the document(s) listed above in a sealed envelope with postage thereon fully prepaid, in the United States mail at Los Angeles, California addressed as set forth below:



**VIA U.S. MAIL**

David Rosenbaum  
 Rosenbaum & Associates PC  
 650 Dundee Road Suite 380  
 Northbrook, IL 60062

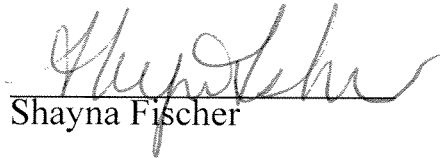
**VIA US. MAIL**

Mark D Litvack  
 Reed Smith LLP  
 355 South Grand Ave Ste 2900  
 Los Angeles, CA 90071

I am employed in the county from which the mailing occurred. On the date indicated above, I placed the sealed envelope(s) for collection and mailing at this firm's office business address indicated above. I am readily familiar with this firm's practice for the collection and processing of correspondence for mailing with the United States Postal Service. Under that practice, the firm's correspondence would be deposited with the United States Postal Service on this same date with postage thereon fully prepaid in the ordinary course of business.

I declare under penalty of perjury that the foregoing is true and correct.

Executed on March 2, 2009, at Los Angeles, California.

  
 Shayna Fischer

OHS West:260619253.1  
 19528-2007 BJH/SF5